

**REMARKS**

This Amendment is filed in response to the Official Action mailed May 5, 2006. In this Amendment, claims 1-3, 6-7, 11-13, 16-17, 19-21, and 27-28 are amended, claims 29-39 are added and claims 4-5, 8-10, 14-15, 18 and 22-26 are unchanged. Following entry of this amendment, claims 1-39 shall be pending.

In the Office Action, claims 23-26 are objected to, and claims 1-22 and 27-28 have been rejected based on prior art and written description grounds. For the reasons set forth below, these claims are now believed to be in a condition of allowance and a notice of allowability is hereby requested.

I. **ALLOWABLE SUBJECT MATTER**

Claims 4-5 and 15-18 have been rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph (as discussed below), including all of the limitations of the base claim and any intervening claims. Specifically, these claims relate as follows:

- Claim 30 is derived from claim 4;
- Claim 31 is derived from claim 5;
- Claim 32 is derived from claim 15;
- Claim 33 is derived from claim 16;
- Claim 34 is derived from claim 17;
- Claim 35 is derived from claim 18;

The Examiner also objected to claim 23-26 because they depend upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In this regard, these new claims relate as follows:

- Claim 36 is derived from claim 23;
- Claim 37 is derived from claim 24;

Claim 38 is derived from claim 25;

Claim 39 is derived from claim 26.

Therefore, in accordance with the Examiner's indication, it is submitted that claims 30-39 are now allowable.

## II. REJECTIONS UNDER 35 U.S.C. SECTION 112

The Examiner rejected claims 1-10 and 27-28 under the first paragraph of 35 U.S.C. 112 as failing to comply with the written description requirement. Specifically, the Examiner asserts that "no support is found in this application for the claim to a "load...distributed laterally in a horizontal plane containing said first and second support rails".

The Applicant disagrees with the Examiner's assertion of a lack of support for this language, especially in view of the numerous figures which illustrate preferred embodiments that conform with this language. However, in an effort solely to expedite prosecution of this application, independent claims 1 and 27 have been amended to remove the "horizontal plane" language. Therefore withdrawal of the Section 112 written description rejections is requested.

The Examiner rejected claims 1-18 and 20-22 under the second paragraph of 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner asserts, for example, that "two support rails cannot be connected along a vertical plane and yet have a connecting structure therebetween".

As to the "vertical plane" terminology, this language has been changed in the appropriate claim to provide greater clarity. As to the "connecting structure therebetween" terminology, the Examiner appears to interpret words such as connected, joined and fixed as ONLY meaning a direct connection to each other. However, this interpretation is overly narrow and ignores the plain meaning of the words.

For example, the Merriam-Webster Online Dictionary defines connect as "to join or fasten together usually by something intervening". Similarly the word join is defined in *The American Heritage® Dictionary of the English Language, Fourth Edition* as "to put or bring into close association or relationship". In yet another example from the same reference, fixed is defined as "securely placed or fastened". While these definitions are merely exemplary, they clearly illustrate that the plain meaning of the words is NOT limited to solely a direct connection or direct contact as the Examiner contends.

Further, as the Examiner is aware, claim language should be given its ordinary meaning unless otherwise defined in the specification (e.g., see MPEP 2111.01). Since the present Application has not defined these terms to limit their meaning to a direct connection or direct contact, it is therefore inappropriate for the Examiner to do so.

For all of these reasons, it is therefore submitted that there is no indefiniteness presented in the claims discussed above. Accordingly, withdrawal of the indefiniteness rejection as it relates to the "vertical plane" and "connecting structure therebetween" terminology is respectfully requested.

Finally, the Examiner also argues that claim 11 is vague with regard to the height of the rails and that claim 27 "appears to be incorrect". As to claim 11, this claim has been amended to better clarify that the rails are positioned at the same height. As to claim 27, it is unclear exactly what the Examiner thinks is wrong with claim 27. Nonetheless, this claim has been amended to further clarify the claim language.

In view of the foregoing, it is submitted that all issues raised by the Examiner under 35 U.S.C. 112 are now addressed and that any indefiniteness that may have been present in the claims is no longer present. Hence, withdrawal of the rejection under section 112, second paragraph is requested.

### III. REJECTIONS UNDER 35 U.S.C. SECTION 102

Claims 1-2 and 8-11 are rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 4,685,857 to *Goeser et al. (The Goeser et al. Patent)*.

For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

Referring first to claim 1, this claim is directed to a slide-out mechanism comprising: a frame; said frame comprising at least one first frame member and at least one second frame member, said at least one second frame member being movable relative to said at least one first frame member; said second frame member comprising: a first support rail having an elongated shape and a longitudinal axis extending along said longitudinal shape; a second support rail having an elongated shape and a longitudinal axis extending along said longitudinal shape; said first support rail being fixedly connected to said second support rail along longitudinally opposing sides of said first support rail and said second support rail at a connecting area, said connecting area having an elongated shape and a longitudinal axis along said longitudinal shape, said longitudinal axis of said connecting area being substantially parallel to said longitudinal axis of each of said first and second support rails; said connecting area comprising at least one connecting member; said first support rail located at substantially the same height as said second support rail such that a top surface of said first support rail is positioned at substantially the same height as a top surface of said second support rail; and a floor structure connected to said second frame member.

*The Goeser et al. Patent* cannot be properly relied upon as anticipating the invention as recited in claim 1. For example, *the Goeser et al. Patent* does not show said first support rail being fixedly connected to said second support rail along longitudinally opposing sides of said first support rail and said second support rail at a connecting area, said connecting area having an elongated shape and a longitudinal axis along said longitudinal shape, said longitudinal axis of said connecting area being substantially parallel to said longitudinal axis of each of said first and second support rails. As seen best in Figure 3 of *the Goeser et al. Patent*, the movable frame members 41 and 42 are connected to each other by frame members 43-46 which have an elongated axis that is perpendicular and therefore not parallel to the elongated axis of the frame members 41 and 42. In other words, the frame members 41, 42 and 43-46

intersect each other at right angles instead of being aligned in a parallel arrangement as recited in claim 1. Further, this perpendicular arrangement fails to provide the advantages of the present invention as described in the specification, such as the improved weight to strength ratio and cost savings of using reduced material. Thus, for at least this reason, *the Goeser et al. Patent* fails to anticipate claim 1. It is also submitted that the *the Goeser et al. Patent* does not render the invention obvious.

Claims 2 and 8-10 depend from claim 1 and thus for at least the above reasons are allowable. However, these claims further define and describe the invention and are thus separately novel and unobvious over the cited prior art.

Referring to claim 11, this claim is directed to a method of moving a slide out compartment on a vehicle comprising: providing a slide out frame having at least two stationary members and at least two movable members; urging said at least two movable members outwardly from the vehicle; and, distributing a weight of said slide out compartment over at least two longitudinally extending support rails which are laterally joined to each other at a connecting area having a longitudinal axis parallel to a longitudinal axis of each of said two longitudinally extending support rails, said connecting area comprising at least one connecting member; said two longitudinally extending support rails being at substantially the same height such that a top surface of each of said support rails is positioned at substantially the same height and which are included as part of each of said at least two movable members.

*The Goeser et al. Patent* cannot be properly relied upon as anticipating the invention as recited in claim 11. For example, *the Goeser et al. Patent* does not show at least two longitudinally extending support rails which are laterally joined to each other at a connecting area having a longitudinal axis parallel to a longitudinal axis of each of said two longitudinally extending support rails. As previously discussed, Figure 3 of *the Goeser et al. Patent*, the movable frame members 41 and 42 are connected to each other by frame members 43-46 which have an elongated axis that is perpendicular and therefore not parallel to the elongated axis of the frame members 41 and 42. Further, this perpendicular orientation fails to provide the advantages of the present invention as

described in the specification, such as the improved weight to strength ratio and cost savings of using reduced material. Thus, for at least this reason, *the Goeser et al. Patent* fails to anticipate claim 1. It is also submitted that the *the Goeser et al. Patent* does not render the invention obvious.

Claims 1-2 and 8-10 are rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,199,894 to *Anderson (The Anderson Patent)*. For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

*The Anderson Patent* cannot be relied upon as anticipating the invention as recited in claim 1. The Examiner argues that "Anderson has first and second frame members 42,30 and support rails 32/48 joined in a vertical plane with load distributed laterally". It is unclear to the undersigned how the *The Anderson Patent* anticipates or even relates to Claim 1. As best understood, this reference relates to a bolt-on truck extender, not a slide-out mechanism. In fact, *The Anderson Patent* does not appear to have any portion that slides, let alone a first and second frame member movable relative to each other. As seen in Figure 3 of *The Anderson Patent*, the bolt-on extender is moved against a portion of the truck so that bolt apertures on the extender and the truck line up and receive a bolt. Once attached, the extender does not appear to move. Further, *The Anderson Patent* does not show said first support rail being fixedly connected to said second support rail along longitudinally opposing sides of said first support rail and said second support rail at a connecting area, said connecting area having an elongated shape and a longitudinal axis along said longitudinal shape, said longitudinal axis of said connecting area being substantially parallel to said longitudinal axis of each of said first and second support rails. At best, *The Anderson Patent* illustrates perpendicularly connecting frame members. Thus, for at least these reasons, the *The Anderson Patent* fails to anticipate claim 1. It is also submitted that *The Anderson Patent* does not render claim 1 obvious.

Turning to claims 2 and 8-10, these claims depend from claim 1 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However,

these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

Claims 1-2, 8-9 and 11 are rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 5,829,945 to *Stanley (The Stanley Patent)*. For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

*The Stanley Patent* cannot be relied upon as anticipating the invention as recited in claim 1. As best understood, the Examiner argues that rail 27A and roller support member 54R/F can somehow be considered a first and second support rail. However, such a comparison with *The Stanley Patent* fails to anticipate the present invention as recited in claim 1. For example, *The Stanley Patent* does not teach a first support rail being fixedly connected to said second support rail along longitudinally opposing sides of said first support rail. As seen in Figures 10 and 11 of *The Stanley Patent* the support member 54R/F is mounted inside of the rail 27A, not along opposing sides as claimed. In another example, *The Stanley Patent* fails to show said first support rail located at substantially the same height as said second support rail such that a top surface of said first support rail is positioned at substantially the same height as a top surface of said second support rail as also claimed. As previously discussed, in *The Stanley Patent* the support member 54R/F is mounted inside of the rail 27A and therefore the top surface of surface of each are not at substantially the same height. Thus, for at least these reasons, the *The Stanley Patent* fails to anticipate claim 1. It is also submitted that *The Stanley Patent* does not render claim 1 obvious.

Turning to claims 2 and 8-9 these claims depend from claim 1 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

*The Stanley Patent* cannot be relied upon as anticipating the invention as recited in claim 11. As best understood, the Examiner argues that rail 27A and roller support

member 54R/F can somehow be considered a first and second support rail. However, such a comparison with *The Stanley Patent* fails to anticipate the present invention as recited in claim 11. For example, *The Stanley Patent* does not teach that said two longitudinally extending support rails being at substantially the same height such that a top surface of each of said support rails is positioned at substantially the same height. In another example, *The Stanley Patent* does not teach distributing (i.e., dividing) a weight of said slide out compartment over at least two longitudinally extending support rails. Instead *The Stanley Patent* shows only rail 27A supporting the floor while roller support member 54R/F supports the rail 27A. In other words, there is no distribution or division of weight between the two members, only direct support. Thus, for at least these reasons, the *The Stanley Patent* fails to anticipate claim 11. It is also submitted that *The Stanley Patent* does not render claim 11 obvious.

Claims 27 and 28 are rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent Application No. 2002/0084664 to *McManus et al.* (*The McManus et al. Application*). For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

The Examiner asserts that "the affidavit of 7/27/2005 reveals that no evidence is provided to establish a date of conception prior to October 24, 2000 regarding the embodiment with two support rails and a connecting member therebetween. Therefore the reference to *McManus et al.* is effective against these claims..." In this regard, claim 27 has been amended so as to be generic as to the embodiment with two support rails and a connecting member therebetween and to the embodiment where the two support rails are directly connected to one another. For the following reasons, the *McManus et al. Application* is therefore not properly applied to claim 27.

Although it may be argued that the Blodgett Affidavit of 7/27/2005 does not explicitly show evidence of the embodiment of the invention where two support rails are connected through an intervening middle support rail, it is submitted that such a showing is not required as to amended claim 27. An explicit showing of this



embodiment is not required since this specific embodiment is merely a species of generic claim 27 to which the 7/27/2005 Blodgett Affidavit relates.

Just as a prior art reference disclosing a specific species of a generic claim may serve as a basis for rejecting such a generic claim, so may conception evidence of a specific species of a generic claim serve as establishing an early invention date for that generic claim. As stated in the MPEP at Section 715.02, Section II:

A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference or activity (assuming, of course, that the reference or activity is not a statutory bar or a patent, or an application publication, claiming the same invention). See *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964).

The 7/27/2005 Blodgett Affidavit shows that the inventor conceived at least of one species of the generic invention prior to the filing date of the *McManus et al. reference*. Hence, in accordance with the MPEP, it does not matter if the *McManus et al. reference* (or any other reference) discloses the same species or a different species; since the filing date of the *McManus et al Application* is not prior to the conception date set forth in the 7/27/2005 Blodgett Affidavit, then the *McManus et al. Application* is not prior art to the generic claim.

In view of the foregoing, *The McManus et al. Application* cannot be properly asserted against amended claims 27 and 28 and should be withdrawn. Similarly, newly added claim 29 depends from claim 27 and for at least the same reasons should not be rejected by *The McManus et al. Application*.

Claim 27 is also rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,338,523 to *Rasmussen (The Rasmussen Patent)*. For at least the reasons set forth below, it is submitted that this prior art rejection should be withdrawn and the pending claim allowed.

*The Rasmussen Patent* cannot be relied upon as anticipating the invention as claimed in claim 27. As asserted by the Examiner, *The Rasmussen Patent* teaches two rails with a perpendicular cross member 40. However, *The Rasmussen Patent* does not teach, for example, said connection portion having an elongated axis positioned parallel to a longitudinal axis of each of said two longitudinally extending support rails such that a load encountered by said second frame member is distributed laterally across a top surface of said first and second support rails. The longitudinal axis of the cross member 40 in *The Rasmussen Patent* is clearly perpendicular to the longitudinal axis of the rail 110, not parallel. Further, both member 110 and 40 are not fixed at substantially the same height. Thus, for at least these reasons, the *The Rasmussen Patent* fails to anticipate claim 27. It is also submitted that *The Rasmussen Patent* does not render claim 27 obvious.

#### IV. REJECTIONS UNDER 35 U.S.C. SECTION 103

Claim 3 is also rejected under 35 U.S.C. Section 103(a) as being obvious by *The Goeser et al. Patent*, *The Anderson Patent* or *The Stanley Patent* in view of the Examiner's assertion that welding two frame members together is common knowledge in this art. Claim 3 depends from claim 1 and thus for at least the above reasons discussed with regard to claim 1 is also novel and unobvious over the cited prior art. However this claim further limits the claimed invention and thus is separately patentable of over the cited prior art.

Claim 19 is also rejected under 35 U.S.C. Section 103(a) as being obvious by *The Goeser et al. Patent* in view of the Examiner's assertion that the lower member being shown slightly smaller in height is deemed to be an obvious expedient to increase the strength of the side wall of member 42.

*The Goeser et al. Patent* fails to make obvious claim 19. For example, claim 19 includes a linking portion positioned between said at least two longitudinally extending support rails; said linking portion further positioned parallel to a longitudinal axis of each of said two longitudinally extending support rails. In contrast and as seen best in Figure

3 of *The Goeser et al. Patent*, the movable frame members 41 and 42 are connected to each other by frame members 43-46 which have an elongated axis that is perpendicular and therefore not parallel to the elongated axis of the frame members 41 and 42. In other words, the frame members 41, 42 and 43-46 intersect each other at right angles instead of being aligned in a parallel arrangement as claimed in claim 19. Further, this perpendicular arrangement fails to provide the advantages of the present invention as described in the specification, such as the weight to strength ratio and cost savings of using reduced material. Thus for at least this reason, *the Goeser et al. Patent* fails to make obvious claim 19.

V. PREVIOUSLY CONSIDERED REFERENCE LISTING

The Examiner indicated that the IDS filed on 8/16/2004 fails to comply with 37 C.F.R. 1.98(a)(1). The submission on this date was intended to provide the examiner with a listing of the references previously considered in the parent case so that these references may be printed on the face of the issued patent, as discussed in MPEP Section 609.02. A new PTO/SB/08A form containing these references is being submitted herewith in accordance with 37 CFR 1.98(a)(1).

**CONCLUSION**

In view of the foregoing, it is submitted that pending claims 1-39 are now in condition for allowance. Hence an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: November 8, 2006

  
\_\_\_\_\_  
Charles E. Fredericks, Esq.  
Registration No. 51,703

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.  
Inskeep Intellectual Property Group, Inc.  
2281 W. 190th Street, Suite 200  
Torrance, CA 90504  
Phone: 310-755-7800  
Fax: 310-327-3466

*Customer No. 37,374*